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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/567,451	02/07/2006	Elke Bleuel	284816US0PCT	8658
22850 7590 10/22/2007 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER GILLESPIE, BENJAMIN	
			ART UNIT 1796	PAPER NUMBER
			NOTIFICATION DATE 10/22/2007	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/567,451	Applicant(s) BLEUEL ET AL.	
	Examiner Benjamin J. Gillespie	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>2/7/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The language “predominantly” renders claim 8 indefinite because “predominantly” is a relative term.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-4, 6-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Hinz et al ('969). Hinz et al teach a method for producing polyurethane comprising the reaction product of polyether polyol and polyisocyanate, wherein the polyether polyol is autocatalytic (Abstract). In particular, patentees explain that the polyether polyol is produced by reacting alkylene oxides, such as ethylene, propylene, and/or butylene oxide in the presence of a starter molecular, which contains at least one tertiary and one primary amino group, and the reaction is aided by alkali based catalyst in amounts that coincide with the range of claim 7 (Col 1 lines 31-34; col 4 lines 1-10; col 5 lines 12, 15-16; examples 1 and 2). Furthermore, patentees teach that other polyether polyol may be present that has a molecular weight ranging from 500 to 8,000 and a functionality

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between 2 and 3, which corresponds to a hydroxyl numbers that overlap applicants' claimed range (Col 6 lines 14-28).

3. Claims 1-6, 8-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Horn et al ('636). Horn et al teach a method for producing polyurethane comprising the reaction product of polyether polyol and polyisocyanate, wherein the polyether polyol is autocatalytic (Abstract; col 3 lines 25-30). In particular, patentees explain that reacting alkylene oxides, such as ethylene, propylene, and/or butylene oxide in the presence of a starter molecular, which contains at least one tertiary and one primary amino group, produces the polyether polyol. Horn et al go on to disclose that the reaction is in the presence of cyclo-hexane solvent and is aided by alkali based catalyst (Col 1 line 14; col 3 lines 35-38; col 5 lines 42-50; col 6 lines 38-41, 67; col 7 lines 1-30). Furthermore, patentees teach that other polyether polyol may be present that has hydroxyl number values between 15 and 65 mg KOH/g (Col 7 lines 46-62).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hinz et al ('969) in view of Horn et al ('636). Aforementioned, both Hinz et al and Horn et al teach a process for producing polyurethane that is based on the reaction product of a polyisocyanate and an autocatalytic polyether polyol. Specifically, Horn et al teach cyclohexane is useful as a solvent in the production of said polyether, but Hinz et al fail in specifying such teaching. Nevertheless,

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it would have been obvious to one of ordinary skill in the art at the time of the invention to include cyclo-hexane organic solvent based on the motivation that Horn et al teach it is useful in the production of autocatalytic polyether compounds and it is prima facie obvious to combine individually old ingredients for their known additive function, i.e. it is obvious to add a known ingredient for its known function. *In re Linder* 173 USPQ 356; *In re Dial et al* 140 USPQ 244.

5. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Horn et al ('636) in view of Hinz et al ('969). Aforementioned, both Hinz et al and Horn et al teach a process for producing polyurethane that is based on the reaction product of a polyisocyanate and an autocatalytic polyether polyol, wherein the polyether polyol is produced in the presence of alkali based catalyst. Horn et al fails however, to disclose how much catalyst is present during the production of said polyether. Nevertheless, it would have been obvious to one of ordinary skill in the art at the time of the invention to employ the catalyst in an amount that corresponds to claim 7 since Hinz et al teach said amount are preferred for the same catalysts in analogous applications, and it obvious to add a known ingredient in an amount that is disclosed by the prior art to be useful for the same application.

Note

6. The reference that has been lined through on the IDS dated February, 7th, 2006 has not been considered because no English translation has been provided. It is noted that the reference is cited on the international search report, however since the search report is not in English the relevance of the document cannot be determined.

Conclusion

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin J. Gillespie whose telephone number is 571-272-2472. The examiner can normally be reached on 8am-5:30pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

B. Gillespie


RABON SERGENT
PRIMARY EXAMINER